

ESTTA Tracking number: **ESTTA613835**

Filing date: **07/03/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91204070
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Date	07/03/2014
Attachments	Brody Chemical Motion for Reconsideration.pdf(317159 bytes )

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7 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
8 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**  
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10 Brody Chemical Company, Inc.

11 Opposer,

12 v.

13 Goldthorpe, Tammy L. fka Tammy Price,

14 Applicant.  
15

**OPPOSITION NO. 91/204,070**

Mark: Slippery Wizard  
Serial No. 85/099,334

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19 **OPPOSER'S MOTION FOR RECONSIDERATION**  
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**Attorneys for Opposer Brody Chemical Company**

1 Pursuant to Trademark Rule 2.127(b), Opposer Brody Chemical Company (“Brody  
2 Chemical” or “Opposer”) hereby moves for reconsideration of the Board’s June 5, 2014 Decision.

3 The Board’s jurisdiction in this matter is limited to determining whether Applicant or Opposer  
4 owns the SLIPPERY WIZARD trademark. The Board found that Opposer has not met its burden to  
5 establish that “Applicant is not the owner of the Slippery Wizard mark.” [Order, at p. 19.].

6 Applicant Goldthorpe’s testimony was that she entered into an oral license agreement with  
7 Brody Chemical for it to (i) use the chemical formula for an asphalt release product sold by her prior  
8 employer RCAI under the designation “ASA-12” and (ii) use the theretofore never used designation  
9 “SLIPPERY WIZARD” to sell product Brody Chemical manufactured using that formula. The  
10 Board found that by a preponderance of evidence that the parties entered in an oral license agreement,  
11 primarily based on the testimony of Brody Chemical’s former national sales manager Matt Forsgren.  
12 [Order at p. 17.] Based on this alleged oral license agreement, the Board found that Applicant’s  
13 conceded non-use of the SLIPPERY WIZARD mark was not determinative because “Opposer’s use  
14 of the SLIPPERY WIZARD mark insured to Applicant’s benefit.” [Order at p. 19.]

15 While Opposer disagrees with the Board’s fact findings regarding the existing of an oral  
16 “license” as opposed to a relatively standard agreement to pay override commissions to an employee  
17 with supervisory and training responsibilities over a particular product line, that finding is not  
18 determinative of the question at hand.<sup>1</sup> Even if one accepts every factual finding made by the Board,

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20 <sup>1</sup> It is worth noting that the holding of *John Anthony, Inc. v. Fashions by John Anthony, Inc.*, cited on  
21 page 17 of the Board’s Order, did not hinge on the existence of an oral license; rather it relied on the  
22 fact that the famous fashion designer MARK ANTHONY did not give up the right to use his name in  
his trade simply because he was at one time employed by the opposer in that case:

23 [T]he courts have always been highly solicitous of an individual’s right to use  
24 his name in the trade . . . . Further, when a name or pseudonym has come to be  
25 recognized in a certain field of business as identifying a particular living  
26 individual, the individual possesses a valuable property right in that name, and  
27 the courts will not allow the name to appropriated or commercially exploited by  
28 another without his consent . . . . In the instant case, the evidence indicates that  
Anthony was known in the world of fashion by the name “JOHN ANTHONY”  
before opposer was formed, and that he never transferred or assigned his rights  
in the name “JOHN ANTHONY” to opposer, but rather merely allowed opposer  
to use the name during the years while he was an employee of opposer.

*John Anthony, Inc. v. Fashions by John Anthony, Inc.* 209 USPQ at 524-525 (TTAB 1980).

1 those facts, along with facts established by the uncontested testimony of Applicant highlighted by  
2 Opposer in its prior briefs, lead to the inescapable legal conclusion that Brody Chemical, not  
3 Applicant, is the owner of the SLIPPERY WIZARD trademark.

4 Based on the TTAB's findings, for purposes of this Motion for Reconsideration only,  
5 Opposer will concede the following facts as undisputed:

- 6 • Applicant developed the chemical formula for the asphalt release product  
7 ASA-12.
- 8 • Matt Forsgren attempted to get Tammy Goldthorpe to license the ASA-12  
9 product to Brody Chemical.
- 10 • Goldthorpe came up with the idea for the name SLIPPERY WIZARD as a  
11 new designation for the ASA-12 Product.
- 12 • Goldthorpe entered into an oral license agreement with Brody Chemical to  
13 license the ASA-12 product, including its formula and the idea for the  
SLIPPERY WIZARD designation.<sup>2</sup>
- 14 • Prior to Joining Brody Chemical in October of 2004 Goldthorpe never sold  
15 an asphalt release product under the name SLIPPERY WIZARD (Tammy  
Goldthorpe Trial Deposition (hereafter, "Goldthorpe Tr."), at p. 29:12-16).
- 16 • For her sales of Brody Chemical's SLIPPERY WIZARD asphalt release  
17 product made during the term of her affiliation with Brody Chemical  
18 (October 2004 through January of 2011), Goldthorpe was compensated as  
19 though she was a W-2 employee of Brody Chemical for all compensation,  
20 *including the override commissions (the alleged "royalties") paid based on  
other Brody Chemical employees' sales of the SLIPPERY WIZARD product.*  
(Goldthorpe Tr. at p. 31:6-22, 32:5-10, 51:21-52:8).
- 21 • The labeling of the SLIPPERY WIZARD product sold by Brody Chemical  
22 has never identified Goldthorpe as the source or sponsor of the product; it's  
23 never been labeled "Tammy Goldthorpe's Slippery Wizard." (Goldthorpe  
Tr., t p. 37:10-14).

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26 <sup>2</sup> The missing terms of the supposed oral "license" that one would expect to find in a true trademark  
27 license include (i) a provision describing whether it was exclusive or non-exclusive, (ii) a provision  
28 describing its initial term, (iii) provisions for renewal, (iv) provisions for termination, (v) provisions  
for quality control, (vi) provisions describing the impact of termination of employment on the  
supposed "license", (vii) provisions for audit rights, and (viii) provisions for indemnity.

- Goldthorpe has not sold any asphalt release product under any name since leaving Brody Chemical's employ in January of 2011. (Goldthorpe Tr., at pp. 35:19-36:24).
- SLIPPERY WIZARD has always and only designated Brody Chemical as the source of the asphalt release product sold under that mark; indeed, the very specimen that Ms. Goldthorpe submitted to the Trademark Office with her application in fact evidences Brody Chemical's use of the SLIPPERY WIZARD mark and not her own.

While Opposer's Opening Brief argued that "[a] party cannot obtain rights for thinking of an "idea" for a trademark" (Opening Brief, at p. 2) the Board did not address this point in its Order. This fundamental principle of trademark law is absolutely critical to the question of whether Brody Chemical's sole and exclusive use of the SLIPPERY WIZARD mark should somehow inure to the benefit of the Applicant as found by the Board in its Order. With all due respect to the Board, *what its June 5, 2014 decision overlooked is the question of whether Ms. Goldthorpe had any trademark rights in the SLIPPERY WIZARD designation to orally license to Brody Chemical back in 2004.* When one applies the foregoing undisputed facts to the law, the answer is an unequivocal "no."

As noted by the leading treatise on trademark law, Ms. Goldthorpe's mere idea of a new name for the ASA-12 asphalt release product does not give rise to trademark rights in that name:

***An Idea for a Trademark is Not a Trademark.*** It is a basic rule of trademark law that a concept or an idea for a new trademark is not itself a "trademark." Rights in a trademark are gained through the use before the relevant public in the marketplace, not through invention. In the United States, it is only public use and public recognition that will create a trademark. Thus, a business plan or a concept for a new trademark does not itself create legally recognizable trademark rights . . . . *The idea person who fails to make sure of the intent-to-use system will find herself without trademark rights and having to rely on the law of trade secrets and confidential disclosures for any possible relief against another's use.*

This rule is the reason that in most situations, an advertising agency that develops an idea for a designation to be used as a trademark as part of an advertising campaign does not own the trademark rights in that designation.

2 McCarthy on Trademarks and Unfair Competition § 16:11 at p. 16-25 (Release # 70, June 2014) (emphasis added).

1 Even more pertinent to the present case is the rule that the “invention” of a designation -- such  
2 as Ms. Goldthorpe’s alleged invention of SLIPPERY WIZARD name -- does *not* create trademark  
3 rights:

4 ***“Invention” of a Designation Does not Create Trademark Rights.*** Unlike  
5 patent law, rights in trademarks are not gained through discovery or invention of  
6 the mark, but through actual usage. Trademark priority is not granted to the  
7 person who was first to conceive of the idea of using a given symbol as a mark.  
8 Many years ago, the U.S. Supreme Court pointed out that the “invention”  
9 concept of patent law has nothing to do with trademarks . . . . To acquire  
10 ownership of a trademark, one must actually use the designation as a mark in the  
11 sale of goods or services. No trademark rights accrue to someone who merely  
12 selects a designation without actual use of it in the advertising or sale of goods.  
Trademark rights grow out of use, not mere adoption. The mere fact that a party  
conceived the idea of a trademark and discussed it with others does not establish  
priority as of the date of those events. Similarly, no priority of use is created as  
of the date that a party announced to a few persons that he intended to use a  
certain designation as a mark.

13 *McCarthy on Trademarks and Unfair Competition* § 16:11 at p. 16-23-25 (Release # 70, June 2014).  
14 *See also Sengohu Works Ltd. v. RMC Intern. , Ltd.*, 96 F. 3d 1217, 1219, 40 U.S.P.Q.2d 1149 (9<sup>th</sup> Cir.  
15 1996), as modified, 97 F.3d 1460 (9<sup>th</sup> Cir. 1996) (“To acquire ownership of a trademark it is not  
16 enough to have invented the mark first or event to have registered it first, the party claiming  
17 ownership must have been the first to actually use the mark in the sale of goods or services”);  
18 *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 401, 413, 36 S. Ct. 357 (1916) (“[T]he right grows out  
19 of use, not mere adoption”); *La Maur Inc. v. International Pharmaceutical Corporation*, 199  
20 U.S.P.Q. 612 (T.T.A.B. 1978) (conception of mark and discussion with others does not establish  
21 priority).

22 Thus in order for Brody Chemical’s “use of the SLIPPERY WIZARD mark” to “insure[] to  
23 Applicant’s benefit” (Order, at p. 19), Applicant must have had some trademark rights in the  
24 SLIPPERY WIZARD designation at the time the parties entered into the alleged oral license. Based  
25 on the facts and the law cited above, she clearly did not. While Applicant may have other rights  
26 under contract law or trade secret law, she clearly does not have *trademark* rights. As a result,  
27 Opposer respectfully requests that the Board reconsider its decision and not allow Applicant’s  
28 SLIPPERY WIZARD trademark application to proceed to publication.

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DATED this 3<sup>rd</sup> day of July, 2014.

DICKINSON WRIGHT PLLC

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CERTIFICATE OF DEPOSIT

I hereby certify that this correspondence is being deposited with the Trademark Trial and Appeal Board via ESTTA on the date indicated below:

Date of Deposit 7/3/14

/David G. Bray/

1 **CERTIFICATE OF SERVICE**

2 The undersigned hereby certifies that a true and correct copy of the foregoing OPPOSER'S  
3 MOTION FOR RECONSIDERATION was served on Applicant by depositing said true and correct  
4 copy with the United States Postal Service, First Class Mail, postage prepaid, this 3<sup>rd</sup> day of July,  
2014, in an envelope addressed to Applicant's attorney of record as follows:

5 Nathan S. Winesett  
6 AVERY, WHIGHAM & WINESETT, P.A.  
7 P.O. Box 3277  
Duluth, MN 88508

8 A courtesy copy of the foregoing was also e-mailed to Mr. Winesett  
9 at [nwinesett@awwlegal.com](mailto:nwinesett@awwlegal.com) on this date.

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